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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,378	09/28/2001	Mitsuaki Oshima	MEIC: 011H	2246
7590	09/28/2004		EXAMINER	
PARKHURST & WENDEL, L.L.P. 1421 Prince Street, Suite 210 Alexandria, VA 22314-2805			DIXON, THOMAS A	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/964,378

Applicant(s)

OSHIMA ET AL.

Examiner

Thomas A. Dixon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 092001.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. It is noted that this application appears to claim subject matter disclosed in prior Application No. 09/866,130, filed 6/22/01. A reference to the prior application must be inserted as the first sentence of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e) or 120. See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. Also, the current status of all nonprovisional parent applications referenced should be included.

If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of

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any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 34 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Specifically, there is no support for the second recording area disposed within the first recording area.

Examiner's Amendment

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3. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a personal interview with Mr Parkhurst et al on 7/10/03.

The application has been amended as follows:

As per Claim 29, line 9.

change --of reading of reading-- to --of reading--

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 29, 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper et al (5,563,946) in view of Dockes et al (5,959,944).

As per Claim 29.

Cooper et al ('946) discloses:

means for recording information using a first modulation method into a first recording area of such an optical disk, see abstract lines 7-9 and column 8, lines 15-18;

means for encrypting information using at least both a cipher key and said disk identification information unique to the optical disk, into encrypted information unique to the same optical disk, see abstract lines 7-9 and column 8, lines 15-18; and

means for permitting recording to said encrypted information by said means for recording after confirming the content of a recording permission code in an input signal to said means for recording, see column 8, lines 24-27.

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Cooper et al ('946) does not teach the disk identification in a second recording area or means for reading disk identification recorded in a second recording area of the optical disk said means including an optical head which is also capable of reading information in the first recording area.

Dockes et al ('944) teaches an identification number stored in another format in the first seconds of silence of the cd and an optical head capable of reading for the benefit identifying individual disks in an unobtrusive way.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to record a disk identifier in a second recording area for the benefit of identifying disks in an unobtrusive way.

As per Claim 34.

Cooper et al ('946) discloses the second recording area is disposed in the first recording area, see abstract, lines 7-9.

5. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper et al (5,563,946) in view of Dockes et al (5,959,944) further in view of Kobayashi et al (5,898,394).

As per Claim 30.

Cooper et al ('946) does not disclose 8/16 modulation.

Kobayashi et al ('394) teaches 8/16 modulation is an old and well known form of modulation for recording data on CDs, see figure 18.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use 8/16 modulation as an old and well known standard for recording data on CDs.

6. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper et al (5,563,946) in view of Dockes et al (5,959,944) further in view of Cooper et al (5,233,576).

As per Claim 31.

Cooper et al ('946) does not disclose PE modulation.

Curtis et al ('576) teaches PE modulation is an old and well known form of modulation for recording data on CDs, see column 5, lines 26-30.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use PE modulation as an old and well known standard for recording data on CDs.

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7. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper et al (5,563,946) in view of Dockes et al (5,959,944) further in view of Kobayashi et al (5,898,394) further in view of Curtis et al (5,233,576).

As per Claim 32.

Cooper et al ('946) does not disclose 8/16 or PE modulation.

Kobayashi et al ('394) teaches 8/16 modulation is an old and well known form of modulation for recording data on CDs, see figure 18.

Curtis et al ('576) teaches PE modulation is an old and well known form of modulation for recording data on CDs, see column 5, lines 26-30.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use 8/16 and/or PE modulation as an old and well known standard for recording data on CDs.

8. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper et al (5,563,946) in view of Dockes et al (5,959,944) further in view of Selby III et al (4,677,604).

As per Claim 33.

Cooper et al ('946) does not disclose circumferentially arranged multiple stripe patterns each stripe of which extends along the radius of the optical disk.

Selby III et al ('604) teaches multiple stripe (bar coding) is an old and well known form of identification recording data on CDs, see figure 1.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use bar coding as an old and well known standard for identifying data on CDs.

Prior Art Made of Record

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Karp (EP 0 302 710) is the closest foreign art that discloses personal computer ID and source id to encrypt, but does not disclose all the limitations of the claims.

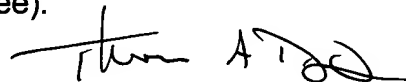
Eickmann is the closest NPL that discloses a disk identification, but does not disclose all the limitations claimed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas A. Dixon
Primary Examiner
Art Unit 3629

September 04